

Amendment and Response under 37 C.F.R. 1.116  
Applicant: Daniel R. Marshall  
Serial No.: 09/759,867  
Filed: January 12, 2001  
Docket No.: 10002307-1  
Title: PORTABLE INFORMATION STORAGE MODULE FOR INFORMATION SHOPPING

### REMARKS

This Amendment is responsive to the Final Office Action mailed April 19, 2004. In that Office Action, the Examiner provisionally rejected claims 1-8, 11-15, 18, 23-29, and 34 under the judicially-created Doctrine of Obviousness-Type Double Patenting as being unpatentable over claims 1-18 of co-pending U.S. Patent Application Serial No. 09/760,242.

The Examiner also rejected claims 30 and 34 under 35 U.S.C. §102(e) as being anticipated by Treyz et al., U.S. Patent No. 6,587,835 ("Treyz"). Claims 1-8 and 11-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz and Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claims 9, 10, 31-33, and 35-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz and Gibson as applied to claims 1-30 and 34 above, and further in view of Gioscia et al., PCT Patent Publication WO/00/30117 ("Gioscia").

With this Response, claims 1-7, 10-13, 15, 18, 23, 24, 29-31, 34, 35, and 37 have been amended. Claims 1-37 remain pending in the application and are presented for reconsideration and allowance.

#### Double-Patenting Rejections

On page 2 of the Office Action, the Examiner provisionally rejected claims 1-8, 11-15, 18, 23-29, and 34 under the judicially-created Doctrine of Obviousness-Type Double Patenting as being unpatentable over claims 1-18 of co-pending U.S. Application Serial No. 09/760,242. The Examiner further indicated that this is a provisional obviousness-type double patent rejection because the conflicting claims have not in fact been patented.

At this time, Applicant is taking no action regarding this provisional rejection and will proceed accordingly once patentable subject matter has been determined.

#### 35 U.S.C. §102 Rejections

On pages 3-5 of the Office Action, the Examiner rejected claims 30 and 34 under 35 U.S.C. §102(e) as being anticipated by Treyz. The Examiner indicated that Treyz teaches both a method of distributing books in electronic readable format and a method of distributing movies in electronic format as claimed in independent claims 30 and 34.

With this Amendment, independent claims 30 and 34 have been amended such that they each include "providing a portable storage module including a memory component sized approximately one square millimeter and capable of storing gigabytes of data with a display".

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Treyz does not teach, disclose, or suggest a portable storage module having a memory component sized approximately one square millimeter and capable of storing gigabytes of data. Therefore, independent claims 30 and 34 are no longer anticipated by Treyz. Applicant respectfully requests that the rejection of claims 30 and 34 under 35 U.S.C. §102(e) be withdrawn.

### 35 U.S.C. §103 Rejections

On pages 5-13 of the Office Action, the Examiner rejected claims 1-8 and 11-29 under 35 U.S.C. §103(a) as being unpatentable over Treyz and Gibson. The Examiner indicated that Treyz teaches each limitation of claims 1-8 and 11-29 other than an atomic resolution storage memory component and its associated subcomponents. The Examiner further indicated Gibson discloses an atomic resolution storage memory component and its associated subcomponents.

With this Amendment, independent claims 1, 15, and 29 have been amended such that each claim includes a portable storage module including a memory component sized approximately one square millimeter and capable of storing gigabytes of data. Support is found for this language in the specification at page 5, lines 7-15. Neither Treyz nor Gibson disclose a portable storage module including a memory component sized approximately one square millimeter and capable of storing gigabytes of data. In particular, Treyz is silent with respect to ultra-high density storage components. While Gibson does teach an ultra-high storage memory device, Gibson is silent as to the sub-miniature sizing of such a device. Gibson does not teach, disclose, or suggest the ability to contain an ultra-high storage memory device within the claimed spatial limitations.

On pages 13-14 of the Office Action, the Examiner rejected claims 9, 10, 31-33, and 35-37 under 35 U.S.C. §103(a) as being unpatentable over Treyz and Gibson, and further in view of Gioscia. Claims 9, 10, 31-33, and 35-37 are all dependent claims, depending from either independent claim 1, 15, 30, or 34. As previously discussed, it is believed that all independent claims are patentably distinguishable over the cited prior art. Therefore, it is also believed that all dependent claims are patentably distinguishable over the prior art.

For the foregoing reasons, it is believed that pending claims 1-37 are patentably distinguishable over the prior art. Therefore, Applicant respectfully requests that the rejection of claims 1-29, 31-33, and 35-37 under 35 U.S.C. §103(a) be withdrawn.

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**CONCLUSION**

In light of the above, Applicant believes independent claims 1, 15, 29, 30, and 34, and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone number to facilitate prosecution of this application.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

Any inquiry regarding this Amendment and Response should be directed to either Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005 or Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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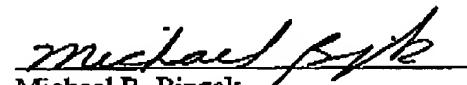
Respectfully submitted,

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By his attorneys,

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